

REMARKS

[0001] Claims 1, 3-4, 8-9, 13-15, 19, 21-22, 26-27, 31-33, 37, 39-40, 44-45, and 49-51 are pending in the application.

[0002] Claims 1, 3-4, 8-9, 13-15, 19, 21-22, 26-27, 31-33, 37, 39-40, 44-45, and 49-51 stand rejected under 35 U.S.C. §103(a) as unpatentable over U.S. Patent Application Publication No. 2002/0016760 to Pathak, in view of “Web Sites Help Small Companies Open Internet Stores--E-Business Service Providers Offer Inexpensive Way to try Something New”, Wall Street Journal, New York, April 25, 2000, by J. Tannenbaum, hereinafter, Tannenbaum.

[0003] Applicants respectfully traverse the rejection and request that the Examiner reconsider the pending claims in view of the following discussion.

I. The 35 U.S.C. 103(a) Rejection as Unpatentable over Pathak and Tannenbaum

A. The Pathak Disclosure

[0004] Pathak discloses a method for trading dissimilar products. A method and apparatus for implementing a mechanism by which a combination of products may be exchanged among market participants. The market participants use an online/computerized auction/bidding system to trade their products. For businesses trying to dispose products, this type of mechanism will result in higher revenue for the seller and at the same time satisfies the buyer. For businesses trying to acquire products, this type of mechanism will result in lowering the cost of procuring products and at the same time satisfies sellers. (Abstract).

[0005] Pathak also discloses the standard ascending auction process involves users bidding for a particular product, and the product is sold to the highest bidder. The aim here is for the seller of the product to sell at the maximum price. (Paragraph [0009], lines 4-8). There is a variation of auction/bidding called the reverse auction. In this type of auction, a buyer posts his wish to buy or procure product or goods or services (this could be a Tender or Request for Proposal (RFP) or Request for Quote (RFQ)). The sellers of the products then bid for it. In this type of auction/bidding the price of the bid generally decreases during the time period of the auction/bidding process. The aim of the buyer here is to buy or procure products at the lowest

price. (Paragraph [0010]). There is another variation of the auction/bidding process where the seller or buyer specifies a reserve price. (Paragraph [0014]).

B. The Tannenbaum Disclosure

[0006] Tannenbaum discloses that specialized Web sites that help little companies go online almost instantaneously and at very little charge are fiercely competing for the attention of small-business owners. Just as midwives can aid pregnant women, these Web sites increasingly help small businesses start online ventures. Besides hosting Web pages or arranging for hosting through a third party, they provide e-commerce tools and related services – often without charge. The services, called e-business service providers, which began appearing about two years ago, are proliferating fast. Now there are more than a dozen sites, such as Bigstep.com ("Where e-business is everybody's business") and BizLand.com Inc. ("Imagine your success. We do."). (Abstract).

[0007] Tannenbaum also discloses that the longevity of some service providers is a question. Most have yet to find a way to make money. They are spending heavily now in anticipation of finding a profitable angle later – such as selling sufficient advertising to third parties or upgrading clients to paid services. (Ninth complete paragraph).

C. Arguments

[0008] Independent claims 1, 19, and 37 recite in relevant part,

"wherein said method is implemented by an online intermediary providing facilities as a service free of charge".

[0009] Applicants respectfully submit the Office Action holds that Tannenbaum teaches an online intermediary (entity hosting) providing facilities as a service free of charge (Tannenbaum, pages 1-2). The Office Action further states that it would be obvious to one of ordinary skill in the art at the time of the invention to modify Pathak to have an intermediary provide this service free of charge in exchange for placing advertisement on the website. (Office Action, page 3, last line to page 4, line 3).

[0010] Applicants maintain that the teachings of Tannenbaum form state of the art in the

year 2000, since they were published on April 25, 2000. These teachings were available to Pathak, in the year 2001 (Pathek's filing date is July 10, 2001) and yet, Pathak makes no indication to claim or to even mention in the text of his document that the method is implemented by an online intermediary providing the facility free of charge.

[0011] Applicants maintain that evidence of non-obviousness includes commercial success (in the U.S. or elsewhere), fulfillment of a long-felt need, failure (unsuccessful attempts) of others, copying by others, unexpected results, and synergism (which is not required). A cause-and-effect connection or "nexus" must be established between the claimed invention (the cause) and each effect (e.g., commercial success).

[0012] The question is whether a cause-and-effect nexus may be established starting from the teaching of Pathak, that is, would one of ordinary skill in the art combine the teachings of Tennenbaum with those of Pathak. Though Tannenbaum's teachings were available to Phatak, himself, the fact that Phatak does not realize such an offering (i.e., a combination of the teachings of Tannenbaum) makes the invention non-obvious to one of ordinary skill in the art, where Phatak can be considered as one highly skill in the art. One of ordinary skill, with common general knowledge, would therefore see no incentive in combining the teaching of Tennenbaum with those of Phatak. Therefore, at the time the invention was made, the invention would be non-obvious to one of ordinary skill.

[0013] To modify the teaching of Pathak, there should be an incentive for the skilled person to do so at the time the invention was made. Since Pathak himself does not see an incentive to do so, why would one of ordinary skill see an incentive to combine the teaching of Tennenbaum with the teaching of Phatak. Further, the fact that there is no single reference, which combines the teaching of Phatak and Tennenbaum, could clearly be an indicator that this fails as a "fulfillment of a long-felt need and commercial success of an online ascending and reverse auction process".

[0014] Furthermore, Applicants maintain that nowhere does Phatak provide a motivation to combine the teachings of Tannenbaum. Therefore, Tannenbaum is an improper reference with which to establish a *prima facie* case of obviousness under 35 U.S.C. §103(a).

[0015] For at least the reasons outlined above, Applicants respectfully submit that

Tannenbaum is an improper reference with which to establish a prima facie case of obviousness under 35 U.S.C. §103(a), because nowhere does Phatak provide a motivation to combine the teach of Tannenbaum with Phatak's disclosure. Withdrawal of the rejection of claims 1, 3-4, 8-9, 13-15, 19, 21-22, 26-27, 31-33, 37, 39-40, 44-45, and 49-51 under 35 U.S.C. §103(a) as unpatentable over Phatak and Tannenbaum is respectfully solicited.

II. Formal Matters and Conclusion

Claims 1, 3-4, 8-9, 13-15, 19, 21-22, 26-27, 31-33, 37, 39-40, 44-45, and 49-51 are pending in the application.

With respect to the rejections of the claims over the cited prior art, Applicants respectfully argue that the present claims are distinguishable over the prior art of record. In view of the foregoing, the Examiner is respectfully requested to reconsider and withdraw the rejections to the claims.

In view of the foregoing, Applicants submit that claims 1, 3-4, 8-9, 13-15, 19, 21-22, 26-27, 31-33, 37, 39-40, 44-45, and 49-51, all the claims presently pending in the application, are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest time possible.

Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary.

Please charge any deficiencies and credit any overpayments to Attorney's Deposit Account Number 09-0441.

Respectfully submitted,

Dated: November 18, 2008

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